

Remarks

Claims 1-20 are presented for the Examiner's review and consideration. Claims 1 and 16 have been amended and claim 20 has been added. Applicant believes the claim amendments, addition, and the accompanying remarks herein serve to clarify the present invention and are independent of patentability. No new matter has been added.

Interview Summary

Applicant appreciates the courtesies extended to Applicant's representatives Seth Blum and Paul Bianco during the telephonic interview conducted August 28, 2006. Applicant respectfully submits that the amendments and remarks presented herein reflect those discussed during the interview.

35 U.S.C. §112 Rejection

Claims 1 and 16 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, it was asserted that the use of the phrase "a permanent magnet" in the claims constituted subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

As an initial matter, Applicant submits that the term "magnet" can refer to a permanent magnet (i.e. a magnet having fixed poles) or an electromagnet. As such, Applicant's use of "a permanent magnet" in the claims is described in the specification.

Furthermore, the present invention discloses a space 146 is defined below plate 128 and above the connection of the rod bundle in which is located the drive shaft 150 of the motor 134 and an eccentrically mounted flywheel magnet 152 fixed to shaft 150. (¶[0016]). As the motor 134 drives the eccentric flywheel magnet 152 via the shaft 150, the action causes the bundle of rods 22 to vibrate. (Id.)

Referring to FIG. 6 and 7, the flywheel magnet 152 is shown attached to the shaft. The flywheel magnet is an individual component, lacking any electronic element, and as such, is not an electromagnet. Accordingly, Applicant submits the specification reasonably conveys to one skilled in the relevant art that the flywheel magnet is a permanent magnet.

In light of the foregoing, Applicant requests reconsideration and withdrawal of the section 112 rejections.

35 U.S.C. §103 Rejections

Claims 1, 5-6, 10-11, 13, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,283,930 to Purvis (“Purvis”) in view of U.S. Patent No. 6,419,649 to Klein (“Klein”).

Purvis discloses a massaging hair brush, which includes a plurality bristle individually mounted in a spaced apart arrangement in a bristle carrier. (See FIGS. 3 and 5). The bristles are mounted in the bristle carrier such that they are aligned in rows, forming six rows and six columns.

Accordingly, Purvis fails to disclose a bundle cap defining a cavity and a bundle of malleable rods having top and bottom ends, wherein the top end of the bundle of malleable rods is secured together within the cavity of the bundle cap. In fact, the bundling of the bristles would make the brush inoperable for its intended purpose, namely brushing hair.

Klein relates to sexual aid devices, specifically to those devices that are used by couples and that attach to the body. (Col. 1, lns. 4-6). As such, Klein has no disclosure relating to bundle of malleable rods. Accordingly, Klein fails to overcome the deficiencies of Purvis even if the two references were combined as suggested. Furthermore, there is absolutely no motivation, suggestion, or teaching to combine the two references since one is a sexual aid device and the other is a hair brush.

Claim 1 recites, *in part*, a head massager including a bundle cap defining a cavity and a bundle of malleable rods having top and bottom ends, wherein the top end of the bundle of malleable rods is secured together within the cavity of the bundle cap and the bottom end of the bundle of malleable rods is free. Claim 16 includes substantially similar elements.

In light of the foregoing, Applicant submits that claims 1 and 16 are patentable over Purvis in view of Klein. As claims 5, 6, 10, 11, and 12 depend from claim 1, these dependent claims necessarily include all the elements of their base claim. Accordingly, Applicant respectfully submits that the dependent claims are allowable over Purvis in view of Klein at least for the same reasons.

Claims 1, 5-6, 10-11, and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 20020049400 to Lacey in view of Klein and U.S. Patent No. 6,592,532 to Haung. (“Haung”).

Lacey discloses a head massage having a handle with a vibrating means and a plurality of fingers attached thereto. The fingers are disclosed as being wedged between the vibrating motor and the inside surface of the housing. As such, the fingers are permanently affixed to the handle, and it is not contemplated nor disclosed that the finger can be removably attached to the handle. Furthermore, Lacey fails to disclose any other mechanism for attaching the fingers to the handle and for transferring the vibration from the vibrational motor to the fingers.

With regard to Haung, the Examiner stated that Haung teaches a similar massage device having a bundle cap removably attached within a recess (fig. 2 and 4). The Examiner further stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Lacey to include a bundle cap, as suggested and taught by Haung, for the purpose of providing attaching means so the bundle of rods can be detachably connected to the handle, thereby allowing the interchanging of different bundles of rods if desired.

Haung discloses a pat type massager, in which the longitudinal lengths of the twigs are patted against the body of the user. Haung discloses the use of spiral twigs to increase the point of contact with the body of the user. The Haung massager is unrelated to a vibrational massager, as disclosed in Lacey, in which the tips of resilient fingers are used to contact the body of the user. The vibrational massager has limited points of contact with the body of the user, being limited to only the tips of the fingers, and as such, is in direct contradiction with the objectives of Haung, namely, to increase the number of contact point along the longitudinal length of the twigs to

to provide a better massager. Furthermore, neither Lacey nor Haung teaches, suggests, or provides any motivation for the removal of and interchanging of the fingers or twigs.

Accordingly, Applicant submits that there is no teaching, suggestion, or motivation in either Lacey or Haung to combine the references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) MPEP §2143.01.

The Examiner also stated that Haung teaches a plurality of projections 12 extending circumferentially around the handle (fig. 4) and surrounding the recess (hole) receiving the top member 14(fig. 4).

As discussed in the Response dated April 18, 2006, Haung only discloses a handle, without making any reference to any projection surrounding the recess hole. Fig. 4 appears to show a handle having a flared end and radial grooves about the circumferences of the handle. However, Haung does not provide any description of the structure of the handle. As such, the Examiner is providing conjecture as to the structure of the handle which is unsupported by the specification.

Furthermore, as is obvious to one skilled in the art, radial grooves positioned about the circumferences of the handle are used to enhance the ability of a user to grip the handle, especially when the user's hand becomes wet.

Accordingly, Applicant submits that Haung does not teach a massage device having a plurality of projections extending from the handle, wherein with the bundle cap removed from the handle, the handle is capable of acting as a massager by pressing the projections against a person while activating the motor to produce vibrations.

However, in order to clarify the claimed subject matter, Applicant has amended claim 1 to recite, *in part*, a plurality of projections extending from said handle about the cap recess.

Klein relates to sexual aid devices and, as such, Klein has no disclosure relating to bundle of malleable rods. Accordingly, Klein fails to overcome the deficiencies of Lacey and Haung.

In light of the foregoing, independent claim 1 is respectfully submitted to be patentable over Lacey in view of Haung and Klein. As claims 5, 6, 10, 11, and 13 depend from claim 1, these dependent claims necessarily include all the elements of their base claim. Accordingly, Applicant respectfully submits that the dependent claims are allowable at least for the same reasons.

Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Lacey in view of and Klein.

As previously discussed, Lacey discloses a head massage having a handle with a vibrating means and a plurality of fingers attached thereto. The fingers are disclosed as being wedged between the vibrating motor and the inside surface of the housing. As such, the fingers are permanently affixed to the handle. Furthermore, and as previously discussed, Lacey fails to disclose any other mechanism for attaching the fingers to the handle and for transferring the vibration from the vibrational motor to the fingers. Additionally, Lacey fails to provide any teaching, suggestion, or motivation for removing the fingers from the handle.

Klein relates to sexual aid devices, specifically to those devices that are used by couples and that attach to the body. As such, Klein has no disclosure relating to bundle of malleable rods. Accordingly, Klein fails to overcome the deficiencies of Lacey.

Claim 16 recites, *inter alia*, a head massager comprising a bundle cap defining a cavity. A plurality of malleable rods are combined together in a bundle form and each having a top end and a bottom end, wherein the top ends of the malleable rods are affixed together within the cavity of the bundle cap and the bottom ends of the malleable rods are free to move independently. A handle is included and has a recess configured to receive bundle cap, wherein the bundle cap is removeably affixed within the recess. A vibration motor is mounted in the handle having an output shaft on which is eccentrically mounted a permanent magnet lying in juxtaposition to but spaced from the bundle cap when removeably attached within the recess of the handle.

In light of the foregoing, independent claim 16 is respectfully submitted to be patentable over Lacey in view of Klein.

Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Lacey in view of Klein and Haung, in further view of U.S. Patent No. 6,119,192 to Harrison (“Harrison”). Claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lacey in view of Klein and Haung, and in further view of U.S. Patent No. D473,949 S to Sorlie (“Sorlie”). Claims 7 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lacey in view of Klein and Haung, and in further view of U.S. Publication No. 2003/0083600 to Robbins et al (“Robbins ‘600”). Claims 8 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lacey in view of Klein and Haung, in further view of Robbins’600, and in further view of U.S. Patent No. 6,450,980 to Robbins et al (“Robbins”). Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Lacey in view of Klein and Haung, and in further view of U.S. Patent No. 6,899,106 to Al-Killidar (“Al-Killidar”).

Claims 2-5 and 9-13 depend from claim 1, and necessarily include all the elements of their base claim. Accordingly, Applicant respectfully submits that the dependent claims are allowable over Lacey in view of Klein and Haung at least for the same reasons. Applicant further submits the inclusion of Harrison, Sorlie, Robbins’600, Robbins, and/or Al-Killidar fail to overcome the deficiencies of Lacey in view of Klein and Haung.

Claims 17-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lacey in view of Klein, in further view of Robbins. Claim 17-19 depend from claim 16, and necessarily include all the elements of their base claim. Accordingly, Applicant respectfully submits that the dependent claims are allowable over Lacey in view of Klein at least for the same reasons. Applicant further submits the inclusion of Robbins fails to overcome the deficiencies of Lacey in view of Klein.

Allowable Claims

Applicant acknowledges that claims 14-15 are in condition of allowance.

New Claim

Claim 20 has been added. Claim 20 is dependent on claim 1, and necessarily includes all the elements of its base claim. Accordingly, Applicant respectfully submits that this dependent claim is allowable at least for the same reasons.

Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

A fee of \$395 is believed to be due for a Request for Continued Examination and the required fee is being paid via credit card. However, please charge any other required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 732-A03-007).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul D. Bianco", with a large, sweeping flourish extending from the end of the signature.

Paul D. Bianco, Reg. # 43,500

Customer Number: 27317

Paul D. Bianco

FLEIT KAIN GIBBONS GUTMAN BONGINI &
BIANCO

21355 East Dixie Highway, Suite 115

Miami, Florida 33180

Tel: 305-830-2600; Fax: 305-830-2605

e-mail: pbianco@focusonip.com